

REMARKS

Claims 1-25 were pending, examined, and rejected. Claim 1 has been amended. Claims 1-25 remain pending. Applicants respectfully request reconsideration and favorable action for the rejected claims.

Rejections under 35 U.S.C. §103(a) based on Smith, Fung, and Ando

Claims 1-9, 11, 14-16, 18-23, and 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication 2002/0198608 by Bruce Allen Smith (“*Smith*”) in view of U.S. Patent Publication 2005/0177755 by Henry T. Fung (“*Fung*”) and Japanese Publication 2000-102166 by Akiro Ando (“*Ando*”).

Claims 10, 17 and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Smith*, *Fung* and *Ando* as applied to claims 1 and 14 above, and further in view of U.S. Patent No. 6,735,704 by David Butka et al. (“*Butka*”).

Claims 12-13 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Smith*, *Fung* and *Ando* as applied to claim 1 above, and further in view of U.S. Patent No. 6,766,222 by Raymond S. Duley (“*Duley*”).

With respect to independent claim 1, Applicant has made broadening amendments and recited that a start-up time for a first server module is based on the unique midplane address of the module and a multiplication factor associated with a duration of the inrush load of at least one of the server modules.

Claim 1 as amended is patentable over the cited references because there is no proper motivation to combine or modify the cited references to arrive at the claimed combination. In order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP 2143.01.

The Office Action correctly acknowledges that Smith does not discuss power management. Smith does not discuss power management because Smith is concerned with and

directed to a problem that is entirely unrelated to power management. Specifically, Smith addresses a problem concerning providing windows of publicly accessible memory space on server modules that are connected to a traditional shared bus such as a PCI bus. As such, Smith is entirely unconcerned with providing facilities to resolve problems associated with satisfying multiple inrush load requirements without over-provisioning the power supply.

One skilled in the art having the benefit of the power management teachings of the secondary references cited in the Office Action would not have been motivated to seek out the teachings of an application directed to defining windows memory space on a shared bus architecture because providing windows of memory space via a shared bus does not alleviate problems associated with multiple, simultaneously occurring inrush loads. Thus, the general scope of Smith is unambiguously outside the pertinent field of endeavor with which the present application is concerned, namely, power management.

When the general scope of a reference is generally outside the pertinent field of endeavor, the reference may, nevertheless, be appropriate to provide the necessary motivation to combine if subject matter disclosed in the reference is relevant to the particular problem with which an applicant is concerned. See, e.g., MPEP 2141.01(a) I, citing, *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003). In this case, however, Smith discusses nothing that is relevant to the particular problem with which Applicants are concerned because Smith does not discuss anything relevant to power management. Only when hindsight is applied to parse Smith's teaching of geographically addressable modules and combine that teaching with power management teachings does the Office Action arrive at the claimed combination. The teaching or suggestion to make the claimed combination must be found in the prior art and not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). MPEP 2143.01. Because there is no such teaching or suggestion found here, Applicants respectfully request the Examiner to reconsider and withdraw the Section 103(a) rejection of Claim 1 as amended.

With respect to independent claims 14 and 23, Applicants respectfully traverse the rejection because there is no motivation to combine or modify the references to arrive at the claimed combinations. Again, the Office Action correctly realizes that Smith does not discuss

power management. Smith is entirely unconcerned with providing facilities to resolve problems associated with satisfying multiple inrush load requirements without over-provisioning the power supply. One skilled in the art having the benefit of the power management teachings of the secondary references cited in the Office Action would not have been motivated to seek out the teachings of Smith because providing windows of memory space via a shared bus does not alleviate problems associated with multiple, simultaneously occurring inrush loads. As indicated above, the general scope of Smith is unambiguously outside the pertinent field of endeavor with which the present application is concerned, namely, power management.

When the general scope of a reference is generally outside the pertinent field of endeavor, the reference may, nevertheless, be appropriate to provide the necessary motivation to combine if subject matter disclosed in the reference is relevant to the particular problem with which an applicant is concerned. See, e.g., MPEP 2141.01(a) I, citing, *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003). In this case, however, Smith discusses nothing that is relevant to the particular problem with which Applicants are concerned because Smith does not discuss anything relevant to power management. Only when hindsight is applied to parse Smith's teaching of geographically addressable modules and combine that teaching with power management teachings does the Office Action arrive at the claimed combination. The teaching or suggestion to make the claimed combination must be found in the prior art and not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). MPEP 2143.01. Because there is no such teaching or suggestion found here, Applicants respectfully request the Examiner to reconsider and withdraw the Section 103(a) rejection of Claim 1 as amended.

Rejections under 35 U.S.C. §103(a) based on Smith, Fung, Ando, and Butka

Claims 10, 17 and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Smith, Fung and Ando* and further in view of *Butka*. Applicants submit that the rejections of claims 10, 17, and 24 are improper for at least the same reasons that the rejection of their respective independent Claims is improper, namely, a lack of proper motivation to combine or modify the cited references to arrive at the claimed combination.

Rejections under 35 U.S.C. §103(a) based on Smith, Fung, Ando, and Duley

Claims 12-13 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Smith*, *Fung* and *Ando* as applied to claim 1 above, and further in view of *Duley*. Applicants submit that the rejections of claims 10, 17, and 24 are improper for at least the same reasons that the rejection of their respective independent Claims is improper, namely, a lack of proper motivation to combine or modify the cited references to arrive at the claimed combination.

Association of Customer Number

Applicants respectfully request that all papers pertaining to the above-captioned patent application be associated with Customer Number **23640**, and direct all correspondence pertaining to this patent application to practitioners at Customer No. **23640**. All telephone calls should be directed to Joseph P. Lally at (512) 322-2680.

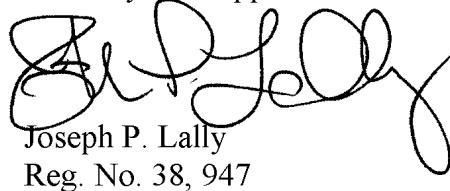
CONCLUSION

Applicants believe that this response contains a reply to each ground of object and rejection set forth in the Office Action. Applicants respectfully request reconsideration and favorable action of the rejected Claims.

Applicants have submitted herewith a fee for extending the period for response. The Commissioner is hereby authorized, nevertheless, to charge any additional fees required or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2680.

Respectfully submitted,
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